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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,732	07/22/2002	Karl Heinz Schmid	C 2078 PCT/US	4550
23657	7590	04/10/2006	EXAMINER	
COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002			COTTON, ABIGAIL MANDA	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/088,732	SCHMID ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Abigail M. Cotton	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 February 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13-27 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 13-27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

This office action is in response to the arguments filed February 2, 2006. Claims 13-27 are pending in the application and are being examined on the merits herein.

Applicant's arguments regarding the rejection of the claims under 35 U.S.C. 103(a) and the judicially created doctrine of double patenting have been fully considered, but have not been found persuasive. Accordingly, these rejections are being maintained and are repeated for Applicant's benefit below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-16 and 19-22 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,432,419 to Kahre et al, issued on August 13, 2002, in view of U.S. Patent No. 5,089,531 to Ira Weil, issued February 18, 1992.

Kahre et al. teaches a cosmetic composition having a nonionic surfactant selected from the group of alkyl or alkenyl oligoglycosides and a fatty compound of hydroxycarboxylic acid esters (see column 3, lines 35-59, and column 1, lines 30-45, in particular.) Kahre et al. further teaches that the fatty compound and nonionic surfactant may be in a ratio by weight of 40:60 to 60:40 to improve sensorial properties (see column 3, lines 36-44, in particular.) Kahre et al. also teaches that suitable hydroxycarboxylic esters are esters of malic acid, tartaric acid and citric acid, with aliphatic alcohols containing 1 to 22 carbons (see column 3, lines 15-34, in particular.) Accordingly, Kahre et al. teaches a composition having an alkyl or alkenyl glycoside and an ester of malic acid, tartaric acid or citric acid with a C<sub>6</sub> –C<sub>22</sub> fatty alcohol, in a ratio by weight of 40:60 to 60:40, as recited in claims 13 and 19.

Regarding claims 14 and 20, Kahre et al. teaches providing an ester with aliphatic alcohols containing 6 to 18 carbon atoms (see column 3, lines 15-19, in particular.) Kahre et al. also teaches that it is preferred to use short-chain hydroxycarboxylic acids, such as malic acid, tartaric acid or citric acid, with long-chain fatty alcohols, such as cocofatty alcohol or cetearyl alcohol (see column 3, lines 29-34, in particular.)

Regarding claims 15 and 21, Kahre et al. teaches a preferred embodiment having an ester with a cocofatty alcohol (see column 3, lines 29-34, in particular), and also that alkyl oligoglucosides based on hydrogenated C<sub>12/14</sub> coconut oil fatty alcohol

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are preferred (see column 4, lines 30-33, in particular.) Regarding claims 25-27, Kahre et al. teaches the surfactant mixture amounts (see column 8, lines 15-65, in particular.)

Accordingly, Kahre et al. teaches the composition and process for enhancing compatibility of a composition comprising the oligoglycoside and a foam stabilizer that is an ester of tartaric, malic or citric acid with a C6-C22 fatty alcohol, and in the weight ratio as recited in claims 13-16, 19-22 and 25-27. However, Kahre et al. does not specifically teach that the hydroxyl carboxylic esters are partial esters, as recited in claims 13-16, 19-22 and 25-27, and also does not teach the specific salt forms recited in claim 16 and 22.

Weil teaches compositions incorporating a salt of a monoester of citric acid (a partial ester) that can be used in skin treatment compositions, and that impart a pleasant smoothness to the skin (see abstract, in particular.) Weil teaches that the hydrophobic group having the ester linkage to the citric acid desirably has 10 to 18 carbon atoms (see abstract, in particular), and thus teaches providing a partial ester of citric acid with a fatty alcohol group having a number of carbon atoms that falls within the limitations of the fatty alcohols recited in claims 13-16, 19-22 and 25-27. Regarding claims 16 and 22, Weil teaches that salts of the monoester that are suitable for such skin treatment compositions include alkaline earth metals and ammonium, among others (see column 10, line 60 through column 11, line 10, in particular.)

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the esters of citric acid and fatty alcohols as in Kahre et al., in the form of the specific partial esters or partial ester salts as taught by Weil, because Kahre et al. teaches the composition having fatty compounds comprising esters of citric acid with fatty alcohols that are suitable for use in cosmetic compositions, and Weil teaches that partial esters of citric acid with fatty alcohols and their salts are suitable for cosmetic compositions such as skin treatment. Accordingly, one of ordinary skill in the art would have been motivated to provide the esters of Kahre et al. in form of partial esters as taught by Weil, with the expectation of providing a composition having fatty compounds that are suitable for cosmetic use.

It is respectfully pointed out that instant claims 15 and 21 are product-by-process claims, as they recite that the components are “derived from” the fatty alcohols. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed Cir. 1985). See MPEP 2113.

Claims 19-22 and 25-27 are directed to a method of enhancing the dermatological and ophthalmic mucous membrane compatibility of a cosmetic and/or

pharmaceutical composition by adding the surfactant mixture to the composition. Since the combined teachings of Kahre et al. and Weil render the claimed composition obvious, the property of such a claimed composition will also be rendered obvious by the prior art teachings, since the properties, namely the enhancement of the mucous membrane compatibility, are inseparable from its composition. Therefore, if the prior art teaches the cosmetic composition or renders the cosmetic composition obvious, then the properties are also taught or rendered obvious by the prior art. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990.) See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess or render obvious the same properties as the instantly claimed product.

Claims 13-15, 16-21 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,432,419 to Kahre et al, issued on August 13, 2002, in view of U.S. Patent No. 5,770,185 to Wachter et al, issued June 23, 1998.

Kahre et al. teaches a cosmetic composition having a nonionic surfactant selected from the group of alkyl or alkenyl oligoglycosides and a fatty compound of hydroxycarboxylic acid esters (see column 9, lines 20-59, in particular.) Kahre et al. further teaches that the fatty compound and nonionic surfactant may be in a ratio by weight of 40:60 to 60:40 to improve sensorial properties (see column 3, lines 36-44, in particular.) Kahre et al. also teaches that suitable hydroxycarboxylic esters are esters of malic acid, tartaric acid and citric acid, with aliphatic alcohols containing 1 to 22

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carbons (see column 3, lines 15-34, in particular.) Accordingly, Kahre et al. teaches a composition having an alkyl or alkenyl glycoside and an ester of malic acid, tartaric acid or citric acid with a C<sub>6</sub> –C<sub>22</sub> fatty alcohol, in a ratio by weight of 40:60 to 60:40, as recited in claims 13 and 19.

Regarding claims 14, 17, 18, 20, 23, 24, Kahre et al. teaches providing an ester with aliphatic alcohols containing 6 to 18 carbon atoms (see column 3, lines 15-19, in particular.) Kahre et al. also teaches that it is preferred to use short-chain hydroxycarboxylic acids, such as malic acid, tartaric acid or citric acid, with long-chain fatty alcohols, such as cocofatty alcohol or cetearyl alcohol (see column 3, lines 29-34, in particular.)

Regarding claims 15 and 21, Kahre et al. teaches a preferred embodiment having an ester with a cocofatty alcohol (see column 3, lines 29-34, in particular), and also that alkyl oligoglucosides based on hydrogenated C<sub>12/14</sub> coconut oil fatty alcohol are preferred (see column 4, lines 30-33, in particular.) Regarding claims 25-27, Kahre et al. teaches the surfactant mixture amounts (see column 8, lines 15-65, in particular.)

Kahre et al. does not specifically teach that the esters of malic, tartaric or citric acid are partial esters, as recited in claims 13-15, 16-21 and 23-27.

Wachter et al. teaches providing fat-soluble hydroxycarboxylic acid esters in topical preparations (see column 1, lines 1-15, in particular.) Wachter et al. teaches that the hydroxycarboxylic acid esters can be esters obtainable by esterification of polybasic hydroxycarboxylic acids, such as tartaric and malic acid, with fatty alcohols containing 12-20 carbon atoms, and even 12 to 18 carbon atoms, which meets the limitations recited in claims 13-14 and 19-20, and can furthermore comprise the partial esters and salts of such compounds (see column 1, lines 35-65 and column 2, lines 1-25, in particular.) Accordingly, Wachter et al. teaches providing in a topical composition, a partial ester of tartaric or malic acid with a fatty alcohol having a number of carbon atoms that meets the limitations of claims 13-15, 16-21 and 23-27.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the esters of malic acid and/or tartaric acid and fatty alcohols as in Kahre et al, in the form of the specific partial esters or partial ester salts as taught by Wachter et al, because Kahre et al. teaches the composition having fatty compounds comprising esters of malic acid and/or tartaric acid with fatty alcohols that are suitable for use in cosmetic compositions, and thus topical use, and Wachter et al teaches that partial esters of malic acid and/or citric acid with fatty alcohols and their salts are suitable for compositions used for topical application to skin. Accordingly, one of ordinary skill in the art would have been motivated to provide the esters of Kahre et al. in form of partial esters as taught by Wachter et al, with the expectation of providing a composition having fatty compounds that are suitable for topical cosmetic use.

It is respectfully pointed out that instant claims 15 and 21 are product-by-process claims, as they recite that the components are "derived from" a fatty alcohol. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed Cir. 1985). See MPEP 2113.

Claims 19-21 and 23-27 are directed to a method of enhancing the dermatological and ophthalmic mucous membrane compatibility of a cosmetic and/or pharmaceutical composition by adding the surfactant mixture to the composition. Since the combined teachings of Kahre et al. and Wachter et al. renders the claimed composition obvious, the property of such a claimed composition will also be rendered obvious by the prior art teachings, since the properties, namely the enhancement of the mucous membrane compatibility, are inseparable from its composition. Therefore, if the prior art teaches the cosmetic composition or renders the cosmetic composition obvious, then the properties are also taught or rendered obvious by the prior art. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990.) See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess or render obvious the same properties as the instantly claimed product.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-16, 19-22 and 25-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,432,419 to Kahre et al, issued on August 13, 2002, in view of U.S. Patent No. 5,089,531 to Ira Weil, issued February 18, 1992.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Kahre et al. claims a cosmetic or pharmaceutical composition comprising hydroxycarboxylic acid esters and alkyl or alkenyl oligoglucosides, in a weigh ratio the encompasses the range recited in the instant claims. Also, while Kahre et al. also claims specific auxiliaries or additives, the "comprising" language of the instant claims leaves the composition open to specific auxiliaries and additives. Kahre

et al. furthermore claims hydroxycarboxylic acids having 3 to 18 carbon atoms with aliphatic alcohols having 1 to 22 carbon atoms, and thus teaches compositions that encompass the ranges recited in the instant claims. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Kahre et al. does not specifically teach providing partial esters or partial ester salts, as recited in the claims. However, Weil discloses that partial esters and salts of fatty alcohol esters of citric acid are suitable for cosmetic use, as discussed above, and thus one of ordinary skill in the art would have been motivated to provide partial esters in the claimed compositions of Kahre et al. based on the teachings of Weil. Accordingly, claims 13-16, 19-22 and 25-27 are not patentably distinct over Kahre et al. in view of the teachings of Weil.

Claims 13-15, 16-21 and 23-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,432,419 to Kahre et al, issued on August 13, 2002, in view of U.S. Patent No. 5,770,185 to Wachter et al, issued June 23, 1998.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Kahre et al. claims a cosmetic or pharmaceutical composition

comprising hydroxycarboxylic acid esters and alkyl or alkenyl oligoglucosides, in a weigh ratio the encompasses the range recited in the instant claims. Also, while Kahre et al. also claims specific auxiliaries or additives, the "comprising" language of the instant claims leaves the composition open to specific auxiliaries and additives. Kahre et al. furthermore claims hydroxycarboxylic acids having 3 to 18 carbon atoms with aliphatic alcohols having 1 to 22 carbon atoms, and thus teaches compositions that encompass the ranges recited in the instant claims. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Kahre et al. does not specifically teach providing partial esters or partial ester salts, as recited in the claims. However, Wachter discloses that partial esters and salts of fatty alcohol esters of malic and tartaric acid are suitable for topical use, as discussed above, and thus one of ordinary skill in the art would have been motivated to provide partial esters in the claimed compositions of Kahre et al. based on the teachings of Wachter. Accordingly, claims 13-16, 19-22 and 25-27 are not patentably distinct over Kahre et al. in view of the teachings of Weil.

***Response to Arguments***

Applicant's arguments regarding the rejection of the claims have been fully considered, but have not been found persuasive.

In particular, Applicants argue that the composition as claimed is not obvious over Kahre et al. in view of Weil, or Kahre et al. in view of Wachter et al., because Applicants assert that Kahre et al. requires the hydrocarboxylic acid esters to be an oil, whereas Weil, for example, teaches obtaining a monoester of citric acid as a precipitate, and thus not in a form that is an "oil."

The Examiner respectfully disagrees with this assertion. Kahre et al. is directed to providing fatty compounds that are suitable to replace silicone in cosmetic and/or pharmaceutical preparations. Kahre et al. teaches that the fatty compound substitute can comprise an oil component that is a hydroxycarboxylic acid ester, such as an ester of citric, malic or tartaric acid with an alcohol, such as a long-chain fatty alcohol. Kahre et al. does not specifically teach that the ester is a partial ester, however it is known to those of ordinary skill in the art that an "oil" is by definition a mixture or different compounds, such as different esterified forms, and thus includes partial esterified forms. One of ordinary skill in the art would also recognize that the fabrication of an oil having esters of di-carboxylic acids such as malic or tartaric acid would necessarily yield a mixture of both full and partial esters. Furthermore, Weil et al. and Wachter et al. teach that the specific partial ester forms as recited in the claims are suitable for topical use. Accordingly, it is considered that one of ordinary skill in the art at the time the invention

was made would have found it obvious to provide the hydroxycarboxylic acid esters of Kahre et al, and including partial esters of the hydroxycarboxylic acids, with the expectation of providing a suitable composition having the fatty substances for topical application.

The Examiner acknowledges and appreciates Applicant's clarification regarding the comparative examples shown in Table 1 of the specification. Applicants have indicated that the examples compare compositions having only the alkyl oligoglucoside (C1-C3), with compositions having the alkyloligoglucoside in combination with partial esters (Examples 1-4 and C4), and point out that the citric dicocylester sodium salt of example 3 is a partial ester (hence the sodium salt), and not a full ester. The Examiner appreciates the clarification. However, the Examiner maintains that this data still does not show unexpected results over the Kahre et al. reference, because Kahre et al. teaches combinations of hydroxycarboxylic acid esters with alkyl oligoglucosides. Thus, one of ordinary skill in the art would expect to obtain good results with this combination. The data shown in Table 1 does not provide unexpected results for combinations of partial esters of the acids with alkyl oligoglucosides over compositions having full esters of the acids with alkyl oligoglucosides, as no comparison between these two compositions is provided. Thus, the data does not show evidence of unexpected results that are sufficient to remove the *prima facie* case of obviousness. Furthermore, as noted in the prior actions of record, the data shown is not commensurate in scope with the subject matter being claimed.

***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

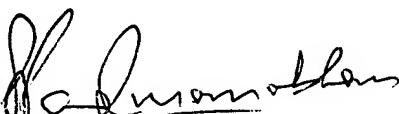
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMC



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER